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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/810,214 | 03/26/2004 | Lisa M. Fisher | 204111-1 (5024-00337) | 8398 |
| 26753 | 7590 | 09/25/2006 | | |
| ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202 | | | | |
| EXAMINER PANNALA, SATHYANARAYA R | | | | |
| ART UNIT 2164 | | PAPER NUMBER | | |

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,214

Applicant(s)

FISHER ET AL.

Examiner

Sathyanarayan Pannala

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/26/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Application No. 10/384102 filed on 3/26/2004 has been examined. In this Office Action, claims 1-25 are pending.

Information Disclosure Statement

2. The information disclosure statement filed on 3/26/2004 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered. Pending patent application is not considered as prior art.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 23-25 recites the limitation "computer readable signal" in line of claims.

There is insufficient antecedent basis for this limitation in the claim.
5. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled

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in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “event” in claims 1-2,10, 14 and 22 is used by Applicant to mean, “event is a data file”, while the accepted meaning is “an action or occurrence.” The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 10-25 are rejected under 35 U.S.C. § 101, because none of the claims are directed to statutory subject matter. Independent claims 10, 14 and 22 deals with simple an abstract idea. A claim that recites a computer that solely calculates a mathematical formula or a computer disk that solely stores a mathematical formula is not directed to the type of statutory subject matter eligible for patent protection. The claims are not producing useful, concrete and tangible results. See *Diehr*, 450 U.S. at 186 and *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 9, 14-19 and 21 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention and the inventor is Bianco et al. (USPA Pub. 2002/0249809 A1) hereinafter Bianco.

10. As per independent claims 1 and 14, Bianco teaches the electronically displaying files include a single electronically displayable file including a treatment pathway timeline display (page 2, paragraph [0017]). Bianco teaches the claimed, an electronic document manager including an electronic image file database for storing the electronic image files (Fig. 2B, page 5, paragraph [0089]). Bianco teaches the claimed, an electronic image file event generator for generating electronic image file events related to the electronic image files and a task engine in communication with said electronic document management module for generating tasks related to the electronic image files based on the contents of said electronic image file events (Fig. 2A, page 5, paragraph [0087]).

11. As per dependent claim 2, Bianco teaches the claimed, task engine further comprises a task generator including an event manager for storing said electronic image file events, a ruleset manager including at least one predetermined set of rules, each of said rules having at least one predetermined condition, and a task generation manager for comparing the electronic image file events to said at least one predetermined set of rules and generating one or more tasks if the electronic image file events meet said at least one predetermined condition (Fig. 4, page 6, paragraph [0092]).

12. As per dependent claims 3 and 15, Bianco teaches the claimed, task engine module further comprises predetermined task instructions for working each of the tasks generated that relate to the electronic image files (Fig. 2B, page 5, paragraph [0089]).

13. As per dependent claims 4 and 16, Bianco teaches the claimed, task instructions include a predetermined workflow (Fig. 2B, page 5, paragraph [0089]).

14. As per dependent claims 5 and 17, Bianco teaches the claimed, task instructions include means for linking to said electronic document manager (Fig. 4, page 6, paragraph [0094]).

15. As per dependent claims 6 and 18, Bianco teaches the claimed, linking allow the electronic image files stored in said database to be viewed in said task engine (Fig. 1, page 5, paragraph [0084]).

16. As per dependent claims 7 and 19, Bianco teaches the claimed, linking include a button control and a hypertext link (Fig. 5, page 7, paragraph [0102]).

17. As per dependent claims 9 and 21, Bianco teaches the claimed, task engine module includes a task list including said tasks relating to the electronic image files (Fig. 2B, page 8, paragraph [0107]).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates

of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

19. Claims 8, 10-13, 20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco et al. (USPA Pub. 2002/0082865A1) hereinafter Bianco, and in view of Mok et al. (USPA Pub. 2003/0140044 A1) hereinafter Mok.

20. As per dependent claims 8 and 20, Bianco does not explicitly teach sorting or filtering electronic documents. However, Mok teaches the claimed, electronic document manager includes one or more method modules for sorting or filtering particular groups of electronic image files and said means for linking is used to execute said one or more method modules (Fig. 6, page 6-7, paragraph [0060]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Mok's teachings would have allowed Bianco's method to manage a complete set of a patient's medical records that allows easy retrieval and meaningful display of relevant information (page 3, paragraph [0012]).

21. As per independent claim 10 and 22, Bianco teaches the electronically displaying files include a single electronically displayable file including a treatment pathway timeline display (page 2, paragraph [0017]). Bianco teaches the claimed, creating one or more electronic image file events related to the electronic image files (Fig. 2A,

page 5, paragraph [0087]). Bianco does not explicitly teach sorting or filtering electronic documents. However, Mok teaches the claimed, providing a predetermined set of rules, each of said rules having at least one predetermined condition and comparing said one or more electronic image file events to said predetermined set of rules and creating one or more tasks if said one or more electronic image file events meets said at least one predetermined condition (Fig. 7, page 8, paragraph [0066]). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Mok's teachings would have allowed Bianco's method to manage a complete set of a patient's medical records that allows easy retrieval and meaningful display of relevant information (page 3, paragraph [0012]).

22. As per dependent claims 11 and 23, Bianco teaches the claimed, one or more tasks include predetermined task instructions for working each of said one or more tasks (Fig. 2B, page 8, paragraph [0107]).

23. As per dependent claims 12 and 24, Bianco teaches the claimed, task instructions include a predetermined workflow (Fig. 2B, page 5, paragraph [0089]).


24. As per dependent claims 13 and 25, Bianco teaches the claimed, task instructions are adapted to link to said electronic document manager (Fig. 4, page 6, paragraph [0094]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sathyanarayan Pannala
Examiner
Art Unit 2164

srp
September 17, 2006